

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY A. BALLESTEROS

Appeal No. 1999-0674
Application No. 08/654,536

ON BRIEF

Before MCCANDLISH, Senior Administrative Patent Judge, NASE and BAHR,
Administrative Patent Judges.

MCCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 8, 17, 18, 23, 24 and 28.¹ No other claims are pending in the application.

Appellant's invention relates to a method (claims 1-8 and 28) of filling a channel within a bagel product with foodstuff and to the resulting product, namely the filled bagel product (claims 17, 18, 23 and 24). The term "bagel product" is defined on page 7 of appellant's specification.

According to the detailed description in appellant's specification (see page 4), a prior art Model PS 4028 foodstuff dispenser unit manufactured by the Edhard Corporation is used to

¹ Following the final rejection (Paper No. 8 mailed September 15, 1997), claims 17 and 23 were amended in the amendatory paper filed October 14, 1997 and marked amendment C (Paper No. 9).

Appeal No. 1999-0674
Application No. 08/654,536

inject foodstuff into the channel in the bagel product. The filling spout used with the dispenser unit is also a prior art article, namely an Edhard spout Model F-3090.

A copy of the appealed claims is appended to appellant's brief. The copy of claims 1 and 23 in the appellant's appendix do not contain the errors asserted by the examiner on pages 2-3 of the answer.²

In rejecting the appealed claims under 35 U.S.C. § 103, the examiner relies upon a 1994 brochure published by the Rheon Company and entitled "Salad Injector," Catalog No. S-FOID-017- 6D (Rheon brochure).³ The examiner also relies on undated publications identified on page 3 of the answer as the "Edhard Pamphlets." The Edhard pamphlets are understood to be the two Edhard publications made of record in appellant's information disclosure statement filed May 29, 1996 (Paper No. 2). In the accompanying form PTO-1449, the first Edhard pamphlet is identified as "Volumetric metering systems for food, etc.," and the second Edhard pamphlet is identified as "Describing Part Numbers, Names, etc." The Rheon brochure was made of record by appellant in a

subsequent information disclosure statement filed August 8, 1996 (Paper No. 4). Both of the Edhard pamphlets and the Rheon brochure are treated as prior art by appellant.

Claims 1 through 8, 17, 18, 23, 24 and 28 stand rejected under 35 U.S.C. § 103(a) as

² As noted in appellant's reply brief, the phrase "that faces the portion of the channel" after the word "spout" in line 14 of claim 1 was deleted in the amendment filed June 11, 1997 (Paper No. 7), and the phrase "pushed in" in line 7 of claim 23 was changed to "pushed aside" in the amendment filed October 14, 1997 (Paper No. 9). Contrary to the examiner's statement on page 3 of the answer, no change was made to claim 23 in the amendment filed November 13, 1997 (Paper No. 11).

³ Contrary to the implication arising from the examiner's identification on page 3 of the answer, this brochure is not a publication in the Japanese language, but instead was merely printed in Japan.

being unpatentable over the Rheon brochure in view of the Edhard pamphlets. Reference is made to the examiner's answer for a discussion of this rejection.

We will sustain the rejection of the product claims 17, 18, 23 and 24, but not the rejection of the method claims 1 through 8 and 28.

With regard to the product, independent claim 17 recites that the filled bagel product comprises an elongated outer surface having two ends, one with an opening and the other being free of any opening. Claim 23, the only other independent product claim on appeal, recites that the filled bagel product comprises an outer surface shaped as a toroid and having at least one opening. Both of the independent product claims recite that the bagel product comprises an interior that is softer than the outer surface, that a channel extends from the opening in the outer surface and that a foodstuff fills the channel. Both of the independent product claims also recite that a border area defining the channel is "in a pushed aside condition caused by displacement of the softer interior into the border area during formation of the channel."

The Rheon brochure teaches the concept of inserting a spout of a food dispenser into an elongated baked bread product to inject foodstuff into a channel in the bread product. The spout may be inserted into the unsliced bread product to form an opening therein as shown on the front of the first or cover page of the brochure. Furthermore, in the third photograph down from the top in the central column of photographs on the backside of the cover page (hereinafter referred to as the "central photograph") at least one of the croissants lacks the appearance of being sliced. In the photograph in the lower right hand corner on the backside of the cover page of the Rheon brochure, the bread product is broken approximately in half to show that the

filled channel extends beyond the mid region of the bread product. The foregoing details, while being somewhat obscure in the black and white photocopies of the Rheon brochure, are clearly discernible from the colored printed copy of the brochure in the file wrapper. Like appellant's bread product, the bread product disclosed in the Rheon brochure has an interior that is softer than the crust or outer surface of the bread product.

The photograph in the lower right hand corner on the backside of the cover page shows that the croissant has an interior channel filled with foodstuff. The presence of such a channel is also evident from the photograph on the front of the cover page of the Rheon brochure due to the penetration of the filling spout. However, as discussed *infra*, the particular manner in which the channel is formed relates to the method of making the bread product and thus is not germane to the patentability of the product itself.

The Edhard pamphlets disclose food dispensing machines of the type having a spout adapted to be inserted into a baked food product (e.g., an éclair or a donut as disclosed on the second page of the pamphlet entitled "Volumetric metering systems, etc.") for injecting foodstuff into the food product similar to the Rheon food dispenser.

Admittedly, the Edhard pamphlets lack an express teaching of filling a bagel product, and the bread product disclosed in the Rheon brochure is a croissant product rather than a bagel product. However, since the provision of bagel dough instead of other bread dough is not stated in appellant's specification to solve any particular problem or to have any unexpected result, the selection of one type of bread dough over the other would have been an obvious matter of choice. Therefore, the recitation of a bagel product does not serve to patentably

Appeal No. 1999-0674
Application No. 08/654,536

distinguish appellant's claimed invention over the prior art. See In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Furthermore, the properties of bagel dough vis-à-vis croissant dough is well known in the prior art, making the substitution of one for the other obvious within the meaning of 35 U.S.C. § 103. See In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 567 (CCPA 1971). Given the knowledge of the properties of bagel dough, such a substitution does not involve a so-called "obvious to try" issue as argued on page 12 of the main brief.

For the reasons discussed *supra*, we disagree with appellant's argument on page 9 of the main brief that "[a]side from the cover page photograph, all the pictures [in the Rheon brochure] show the croissant sliced open with foodstuff deposited at the sliced open portion." Moreover, none of the product claims excludes a sliced product. In any

case, the photograph on the front of the cover page of the Rheon brochure is sufficient to support the rejection of the product claims.

Appellant's arguments relating to the length of the channel in the bread product (see pages 6, 7, 14, 15 and 16 of the main brief) are not persuasive. In the first place, claim 17 does not recite that the channel "extends at least as long as a majority of the length of the bagel" as argued on page 7 of the main brief. Instead, claim 17 more broadly recites that the channel extends "by a distance at least as long as a majority of a length of said elongated outer surface, . . ." (emphasis added). The recitation of "a length" may be any length and thus is not limited to the entire length of the outer surface. Thus, the language relating to the length of the channel in

claim 17 is broad enough to read on the filled channel in the Rheon bread product even if it is assumed for the sake of argument that the channel in the Rheon bread product does not extend the majority of the length of the croissant (see the argument on page 15 of the main brief).

On page 6 of the main brief, appellant concedes that the filling spout penetrates the crust of the croissant in the photograph on the front of the cover page of the Rheon brochure. Such a penetration unquestionably forms an opening in the outer surface of the croissant and additionally forms a channel within the croissant.

Appellant nevertheless appears to argue on page 7 of the main brief that a channel is not formed with a border area in a “pushed aside condition” upon the insertion of the filling spout into a croissant because of “large air pockets” (main brief, page 7) or “a huge air pocket” (reply brief, page 5) in a croissant such as the one shown in the photograph on the front side of the cover page of the Rheon brochure. This argument is not persuasive for a number of reasons.

In the first place, while a croissant may have air pockets, the interior of the croissant is not devoid of soft dough material. In fact, appellant seems to concede on page 6 of the main brief that some interior material (i.e., dough) will be displaced by the insertion of the filling spout. Such a displacement the interior soft dough is unavoidable and consequently inherent to result in the formation of a channel for receiving foodstuff. It is even feasible that an air pocket is capable of being formed by “pushing aside” some croissant dough material.

Furthermore, the appealed product claims are not drafted in such a way to exclude air pockets, and bagel dough is not inherently devoid of any and all air pockets, which could occur as a result of mixing the ingredients for the dough. In addition, the product claims do not

exclude a channel that may be formed in part by an air pocket. Indeed, the manner in which the channel is formed is a method limitation and thus does not serve to patentably distinguish the claimed product. In this respect, patentability of a product claim is based on the product itself and not on the process by which the product was formed. See In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).

In the present case, the appealed product claims contain a method limitation relating to the manner in which the channel is formed, namely the recitation in claims 17 and 23 that the border area of the channel is “in a pushed aside condition caused by displacement of the softer interior into said border area during formation of the channel.” Such a method limitation is not entitled to weight in determining the patentability of the product claims on appeal in this case. Id. Furthermore, even if it were required to give this limitation patentable weight, the insertion of filling spout into the bread product in the Rheon brochure will inherently push aside some dough, and the displacement of even “minor interior material” as noted on page 6 of the main brief is sufficient to meet the method limitation quoted supra.

We are not unmindful of the arguments by appellant’s counsel that the foodstuff injection pressure in the Rheon dispenser is insufficient to form a channel in bagel dough because of the density of bagel dough (see pages 8 and 11 of the main brief and pages 3 and 7 of the reply brief). These arguments are unpersuasive and are unsupported by any competent evidence entered in the record before us.

In the Rheon dispenser, the formation of a channel in the bread product does not depend on the foodstuff injection pressure. Instead, a channel of sufficient length to meet the

terms of the product claims is formed by the insertion of the filling spout into the bread product as discussed supra. It is sufficient that the filling spout on the Rheon dispenser is capable of penetrating a variety of bread products, including bagel products. Appellant is understood to admit on page 3 of the reply brief that the Rheon dispenser is not limited to use with croissants.

Furthermore, the rejection of the product claims is not based on the Rheon brochure alone. Instead, the rejection is based on the Rheon brochure and the Edhard literature discussed supra. Since the prior art Edhard dispenser and filling spout equipment selected by appellant were commercially available at the time of appellant's invention, it follows that the advantages of that equipment were also known in the art to provide the appropriate motivation needed to inject foodstuff into bread products other than croissants.

With particular regard to claim 23, bread products having a toroidal shape are well known in the art. Furthermore, the Edhard pamphlet identified as "Volumetric metering systems for food, etc." (hereinafter referred to as the Edhard metering systems pamphlet) recognizes a toroidal bakery product shape as an alternative to an elongated shape. This evidence taken collectively would have been ample motivation for one of ordinary skill in the art to provide a bread product with a toroidal shape. In any case, since a toroidal bread product solves no stated problem and has no unexpected result in appellant's invention, the use of one shape or the other would have been an obvious matter of design choice. See In re Kuhle, 526 F.2d at 555, 188 USPQ at 9. As a result, the recitation in claim 23 that the product has a toroidal shape does not patentably distinguish the subject matter of claim 23 over the prior art.

We also disagree with appellant's argument on page 7 of the main brief that claim 23

patentably distinguishes over the prior art by reciting that the channel extends from an opening in the outer surface “toward the other end in a direction of curvature of the outer surface . . .” Since, by definition, a toroidal shape has no ends, the only reasonable interpretation of the language in claim 23 is that the recitation of “the other end” refers to the end of the channel opposite from the opening in the outer surface. Given this interpretation, the language in claim 23 is broad enough to read on a channel of any length. As such, the limitation concerning the length of the channel in claim 23 is broad enough to read on the curved channel in the Rheon bread product as well as the channel formed in the donut product disclosed in the Edhard metering systems pamphlet. As for appellant’s arguments on page 8 of the main brief, neither claim 23 nor any other product claim on appeal is limited to the particular type of filling spout or any other part of the filling apparatus. In any case, these arguments are not supported by any evidence, and it is well settled that arguments of counsel cannot take the place of evidence. See In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

In support of the arguments about the inadequacy of the Rheon foodstuff injection pressure, appellant has submitted two letters. The first letter is dated December 18, 1997 and accompanied an unnumbered faxed letter dated December 18, 1997⁴ and styled “Transmittal.”⁵ This first letter lacks the signature of the writer. According to the letterhead, however, it was transmitted from a company called “The Sandwich Factory” and was sent to Debbie Iannucci, a sales coordinator at Rheon. Ms. Iannucci wrote remarks on the Sandwich Factory letter and

⁴ The examiner’s statement on page 8 of the answer (which itself is dated June 3, 1998) that this letter was filed with a response dated “Dec. 23, 1998” is an obvious error.

⁵ Upon return of this application to the Technology Center, a review of the file wrapper contents is advisable to ensure that all papers are appropriately numbered and listed in the file wrapper contents.

Appeal No. 1999-0674
Application No. 08/654,536

presumably returned it to the Sandwich Factory. It is understood that this letter was entered into the record by the examiner.

The second letter (Paper No. 22) submitted by appellant is from Debbie Iannucci, the sales coordinator at Rheon, and is dated June 16, 1998. This second letter was filed with appellant's reply brief. The examiner refused to enter this second letter (see the advisory office action dated April 2, 2001 (Paper No. 25)). Accordingly, the second letter (Paper No. 22) is not before us for consideration.

The notations made by Ms. Iannucci on the Sandwich Factory letter of December 18, 1997 are not entitled to probative weight. In the first place, 37 CFR § 1.132 provides for evidence only in the form of affidavits or declarations (i.e., declarations under 37 CFR § 1.68) for traversing a ground of rejection. See Ex parte Mayer, 6 USPQ2d 1966, 1968 (Bd. Pat. App. & Int. 1988). In the present case, the document in question is merely an unsworn letter, not a declaration. As a result, it is not competent evidence and therefore cannot be taken as establishing the truth or falsity of representations asserted therein. See In re Hunter, 167 F.2d 1006, 1008, 77 USPQ 610, 612 (CCPA 1948) and Ex parte Mayer, 6 USPQ2d at 1968. Furthermore, there is no evidence entered in the record before us to establish that Ms. Iannucci qualifies as a person skilled in the art or, at the very least, has personal knowledge about the injection of foodstuff into a bagel product. Arguments of counsel dealing with Ms. Iannucci's qualifications (see page 20 of the main brief) cannot take the place of evidence. See In re Pearson, 494 F.2d at 1405, 181 USPQ at 646. In view of the foregoing, there is no competent evidence entered in the record before us to support the argument of appellant's

Appeal No. 1999-0674
Application No. 08/654,536

counsel that pressure of the injected foodstuff in the Rheon injector is required to form the channel in the bread product.

For the foregoing reasons, we are satisfied that the combined teachings of the applied prior art establish a prima facie case of obviousness with respect to appealed claims 17 and 23.

Turning now to appellant's evidence of nonobviousness, we are mindful of the necessity of reweighing the entire merits of the matter and hence considering all of the evidence of record anew. In re Piasecki, 745 F.2d 1468, 1474, 223 USPQ 785, 788 (Fed. Cir. 1984).

In the present case, the only item of nonobviousness is a newspaper article entitled "A wholly holeless bagel" published in the March 5, 1997 edition of USA Today (Paper No. 5½). Appellant relies on this article as evidence of "a long felt problem" (main brief, page 18) presumably solved by appellant's invention. We disagree with appellant's argument about this article for the reasons set forth below.

At the outset, it is noted that the newspaper article mentioned above does not mention appellant, let alone crediting appellant with a solution to the foodstuff spillage problem. Instead, a third party, Larry Bares, is credited with that solution.

Furthermore, to establish a long felt need, appellant must demonstrate the existence of a problem which has been recognized in the art and remained unsolved over a long period of time despite efforts to solve the problem until appellant's invention. Vandenberg v. Dairy Equipment Co., 740 F. 2d 1560, 1567, 224 USPQ 195, 199 (Fed. Cir. 1984). The newspaper article does not provide such evidence. More importantly, the prior art in the record before us conclusively establishes that the problem of spillage of cream cheese or other foodstuff from a

Appeal No. 1999-0674
Application No. 08/654,536

sliced bagel or other bread product was solved prior to appellant's invention. See, for example, the U.S. Patent No. 5,236,724 issued to Alvin Burger on August 17, 1993, as well as the U.S. Patent No. 4,963,377 issued to Paul Rimmeir on October 16, 1990.

After reviewing all of the evidence before us, we are satisfied that when all the evidence is considered, including the totality of the evidence of nonobviousness, the evidence of nonobviousness is insufficient to overcome the evidence of obviousness as in Ryko Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 719, 21 USPQ2d 1053, 1058 (Fed. Cir. 1991). We will therefore sustain the § 103 rejection of claims 17 and 23. We will also sustain the § 103 rejection of dependent claims 18 and 24 because the patentability of these claims has not been argued separately of their respective parent claims. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and In re Burckel, 592 F.2d 1175, 1178-79, 201 USPQ 67, 70 (CCPA 1979).

We will not sustain the § 103 rejection of method claims 1-8 and 28. The examiner has not adduced sufficient evidence to establish that the particular filling

method defined in claim 1, the only independent method claim on appeal, would have been obvious from the applied references. There is no teaching or suggestion in the applied references of steps (b) and (c) in claim 1, namely the steps of moving the bagel product and the spout relative to each other in a withdrawing direction to leave a portion of the channel free of the spout, and then filling the free portion of the channel.

Under the provisions of 37 CFR § 1.196(b), the following new ground of rejection is

entered against product claims 17, 18, 23 and 24:

Claims 17, 18, 23 and 24 are rejected under 35 U.S.C. § 103 as being unpatentable over Hayachi et al. ("Hayachi")⁶ in view of Burger (cited *supra*), the Edhard pamphlets (also cited *supra*), the prior art Edhard equipment used by appellant (namely the Edhard dispenser Model No. PS 4028 and the Edhard filling spout Model No. F-3090 as set forth on page 4 of appellant's specification) and the Rheon brochure (also cited *supra*).⁷

The Hayachi patent discloses a bread product which is filled with foodstuff by a foodstuff dispensing apparatus having a filling spout 10. In Figure 5 of the Hayachi patent, the bread product 36 is shown to have an elongated configuration. In any event, as stated *supra*, the particular shape of the bread product is a matter of design choice and thus does not serve to patentably distinguish the claimed product over the prior art. As described in column 5, lines 12-25, of the Hayachi specification the filling spout is first inserted into the bread product so that, like appellant's apparatus, the inclined discharge end of the spout will inherently form a channel in the bread product before the filling is injected into the bread product. The stroke of the foodstuff delivery piston 25 is then set (see column 5, lines 25-30 of the Hayachi specification), and the piston is thereafter advanced to inject the foodstuff into the channel formed by the spout (see column 5, lines 28-45 of the Hayachi specification). The channel formed by insertion of the spout is of sufficient length to meet the terms of the product claims for reasons discussed *supra* in our analysis of the Rheon brochure.

⁶ U.S. Patent No. 4,669,967 issued on June 2, 1987.

⁷ The Hayachi reference was made of record by appellant in the response (Paper No. 13) filed December 12, 1997 after the final rejection. The Burger reference was cited by the examiner during examination of this application. The Edhard and Rheon references were made of record in appellant's information disclosure

The formation of the channel in Hayachi's bread product is reinforced by our prior analysis of the Rheon dispenser and our discussion of appellant's concessions regarding the Rheon dispenser. As noted in our review of the examiner's rejection, the recitation in claims 17 and 23 that the border area of the channel is "in a pushed aside condition caused by displacement of the softer interior into said border area during formation of the channel" is a method limitation. It therefore is not entitled to weight in determining the patentability of the product claims on appeal in this case. See *In re Thorpe*, 777 F.2d at 697, 227 USPQ at 966. In any case, even if it were required to give this limitation weight in determining the patentability of claims 17 and 23, the insertion of Hayachi's spout into the bread product will inherently push aside some interior dough to meet the limitation that the border area of the channel is in a "pushed aside condition." Furthermore, since the prior art Edhard dispenser and filling spout equipment selected by appellant were commercially available at the time of appellant's invention, it follows that the advantages of that equipment were also known in the art to provide the appropriate motivation to utilize that equipment in the Hayachi apparatus to prepare the bread product in the Hayachi patent. With regard to claim 23, one of ordinary skill in the art would have recognized that a curved channel is advantageously formed in a toroidal bread product in light of Edhard's teaching of filling a donut and utilizing a curved filling spout as discussed *supra*.

With further regard to claim 23, bread products having a toroidal shape are well known in the art. Furthermore, the Edhard metering system pamphlet recognizes a toroidal bakery product shape as an alternative to an elongated shape. This evidence taken collectively would

have been ample motivation for one of ordinary skill in the art to provide a bread product with a toroidal shape. In any case, since a toroidal bread product solves no stated problem and has no unexpected result in appellant's invention, the use of one shape or the other would have been an obvious matter of design choice. See In re Kuhle, 526 F.2d at 555, 188 USPQ at 9. As a result, the recitation in claim 23 that the product has a toroidal shape does not patentably distinguish the subject matter of claim 23 over the prior art.

As discussed *supra*, the only reasonable interpretation of the language in claim 23 is that the recitation of "the other end" refers to the end of the channel opposite from the opening in the outer surface. Given this interpretation, the language in claim 23 is broad enough to read on a channel of any length. As such, the limitation concerning the length of the channel in claim 23 is broad enough to read on any channel length.

The Hayachi patent is silent as to the particular type of bread product to be filled by the Hayachi apparatus. Thus, the appealed product claims admittedly differ from the Hayachi bread product by specifically reciting that the bread product is a bagel product. However, Burger suggests the concept of injecting cream cheese into a bagel product to eliminate the need for slicing. Such a teaching would have been ample motivation to utilize bagel dough in preparing the bread product in the Hayachi patent. In any case, as previously discussed, since the selection of bagel dough is not stated in appellant's specification to solve any particular problem or to have any unexpected result, the selection of one type of bread dough over the other would have been an obvious matter of choice. Therefore, the recitation of a bagel product does not serve to patentably distinguish appellant's claimed invention over the prior art.

Appeal No. 1999-0674
Application No. 08/654,536

See In re Kuhle, 526 F.2d at 555, 188 USPQ at 9.

Finally, Ms. Iannucci's reply on the Sandwich Factory letter of December 18, 1997 is not entitled to probative weight and is not competent evidence for the reasons discussed supra. Furthermore, the Rheon brochure is utilized in our rejection under 37 CFR § 1.196(b) to merely reinforce the teachings of Hayachi.

For the foregoing reasons, we are satisfied that the combined teachings of Hayachi, Burger, the Edhard pamphlets, the Edhard dispenser and filling spout equipment used by appellant and the Rheon brochure establish a prima facie case of obviousness with respect to appealed claims 17, 18, 23 and 24.

With regard to appellant's evidence of nonobviousness (namely the newspaper article in USA Today), we are again mindful of the necessity of reweighing the entire merits of the matter and hence considering all of the evidence of record anew with respect to our new ground of rejection. In re Piasecki, 745 F.2d at 1474, 223 USPQ at 788. However, for the reasons discussed supra, that newspaper article lacks probative value. We are therefore satisfied that when all the evidence is considered, including the totality of the evidence of nonobviousness, the evidence of nonobviousness is insufficient to overcome the evidence of obviousness adduced in our new § 103 rejection of the appealed claims under 37 CFR § 1.196(b).

The examiner's decision to reject claims 1 through 8, 17, 18, 23, 24 and 28 is affirmed with respect to claims 17, 18, 23 and 24, but is reversed with respect to claims 1 through 8 and 28. A new ground of rejection of claims 17, 18, 23 and 24 has been introduced pursuant

Appeal No. 1999-0674
Application No. 08/654,536

to the provisions of 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellants may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred

Appeal No. 1999-0674
Application No. 08/654,536

until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART
37 CFR § 1.196(b)

Harrison E. McCandlish, Senior)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
Jeffrey V. Nase)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
Jennifer D. Bahr)	
Administrative Patent Judge)	

Appeal No. 1999-0674
Application No. 08/654,536

HMcC/cam
Cobrin, Gittes & Samuel
750 Lexington Avenue
New York, NY 10022